

REMARKS

In response to the Office Action dated October 25, 2001 (Paper No. 17), claims 1, 2 and 13 have been amended and new claim 18 has been added. Therefore, claims 1-18 are now in the case. Reexamination and reconsideration of the application as amended are requested.

The Office Action rejected claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. (U.S. Patent No. 6,012,044).

The Applicants respectfully traverse this rejection based on the arguments below.

The Office Action contended that Maggioncalda et al. disclose all elements of the Applicant's claimed invention except for preventing sub-item conflicts using transmitted rules of enforcement and the rules of enforcement for sub-item combination to be processed in the background. However, the Office Action further stated that these elements would have been inherent to a method such as set forth in Maggioncalda et al. so as to allow the processing of transmitted results transparently to users and display sub-items in combination logically and properly.

The Applicants respectfully disagree with these statements. It is the Applicants' position that the reference of Maggioncalda et al. is not prior art in relation to Applicants' invention.

In general, as set forth in 37 CFR § 1.131, if a reference does not claim the same patentable invention as the applicant, and the applicant reduced the invention to practice in the United States prior to the effective date of the reference, then the reference is not prior art in relation to the applicant's invention. The Applicants respectfully maintain that these circumstances exist in the subject case.

First, Maggioncalda et al. do not claim the same patentable invention as the Applicants. In accordance with 37 C.F.R. § 1.601(n), the "same patentable invention" is one where an applicant's invention is anticipated under 35 U.S.C. § 102 or obvious under 35

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U.S.C. § 103. The Applicants' claimed invention is not anticipated by Maggioncalda et al. because Maggioncalda et al. lack at least one claimed element of the Applicants' invention. In particular, Maggioncalda et al. lack the Applicants' claimed element of preventing sub-item conflicts using transmitted rules of enforcement. Consequently, Maggioncalda et al. does not anticipate the Applicants' claimed invention.

The Applicants' claimed invention also is not obvious under 35 U.S.C. § 103 in view of the Maggioncalda et al. reference. A prima facie showing of obviousness must consider all of the claimed elements of an applicant's invention, especially when these claimed elements are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie showing of obviousness has been made. The Federal Circuit Court has held that it was an error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Moreover, if the prior art references do not disclose, suggest or provide any motivation for at least one claimed element of an applicant's invention then a prima facie case of obviousness has not been established (MPEP § 2142).

Independent claims 1, 2 and 13 of the Applicants' invention includes rules of enforcement that are used to prevent sub-item conflicts. In contrast, as noted in the Office Action, Maggioncalda et al. do not disclose this claimed element. Moreover, Maggioncalda et al. fail to appreciate the advantages of the rules of enforcement. Specifically, the rules of enforcement prevent any conflicts involving sub-items, thereby preventing a user from selecting invalid combinations when interactively manipulating data.

Accordingly, the Applicants respectfully contend that the independent claims 1, 2, and 13 are nonobvious over the Maggioncalda et al. reference. Further, claims 6-12 depend from independent claim 1, claims 3-5 depend from independent claim 2, and claims 14-17 depend from independent claim 13. It follows, therefore, that these dependent claims are also nonobvious over the Maggioncalda et al. reference (MPEP § 2143.03).

Thus, the Applicants' invention is not the "same patentable invention" as Maggioncalda et al. under 37 C.F.R. § 1.601(n) because the Applicants' invention is neither

anticipated by Maggioncalda et al. under 35 U.S.C. § 102 nor obvious in view of Maggioncalda et al. under 35 U.S.C. § 103. Accordingly, the Maggioncalda et al. reference does not claim the same patentable invention as the Applicants' invention.

Second, in order to prove that the Maggioncalda et al. reference is not prior art in relation to the Applicants' invention, it also must be shown that the Applicants reduced the invention to practice in the United States prior to the effective date of the Maggioncalda et al. reference. The effective date of Maggioncalda et al. is the filing date of May 25, 1999. Because Maggioncalda et al. is a continuation of U.S. Patent 5,918,217, however, in certain situations the effective date of Maggioncalda et al. may be the filing date of the parent, or December 10, 1997.

In either case, the Applicants' reduction to practice is before the earliest effective date of December 10, 1997 of the Maggioncalda et al. reference. The Applicants reduced the invention to practice at Microsoft Corporation in Redmond, Washington prior to the earliest effective date of December 10, 1997. This is evidenced by the attached declaration of one of the Applicants and an associated exhibit. The declaration states the reduction to practice occurred prior to December 10, 1997, and the exhibit supports this statement. The exhibit is an e-mail, dated October 3, 1997, from a leader on the CarPoint development team to other members of the team indicating that the beta version of Carpoint version 2.0 is ready for beta testing. Moreover, the declaration signed by one of the inventors states that the beta version of Carpoint version 2.0 referred to in the e-mail includes the Applicants' claimed invention. The e-mail along with the declaration proves reduction to practice, and the date of the e-mail proves that reduction to practice occurred at least before December 10, 1997. The date of the e-mail is at least over two months before any of the effective dates of the Maggioncalda et al. reference. Accordingly, the Applicants respectfully submit that they have shown that the required reduction to practice in the United States prior to any effective dates of the Maggioncalda et al. reference.

The Applicants have shown that Maggioncalda et al. do not claim the same patentable invention as the Applicants' invention and that the Applicants reduced the invention to practice in the United States prior to any effective date of the Maggioncalda et al. reference. Consequently, the Applicants respectfully submit that the Maggioncalda et al.

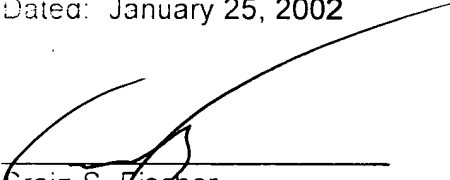
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reference is not prior art in relation to the Applicants' invention. Accordingly, the Applicants' invention is patentable in view of Maggioncalda et al. under 35 U.S.C. § 103(a).

In view of this unavailability of Maggioncalda et al. as prior art, the Applicants respectfully submit that the rejection of claims 1-17 under 35 U.S.C. § 103(a) as being unpatentable over Maggioncalda et al. has been overcome. The Applicants, therefore, respectfully request reexamination, reconsideration and withdrawal of the rejection of claims 1-17 under 35 U.S.C. § 103(a). The Applicants also submit that new claim 18 is patentable over the cited reference.

In view of the arguments set forth above, the Applicants respectfully submit that claims 1-18 of the subject application are in immediate condition for allowance. The Examiner is respectfully requested to withdraw the outstanding rejections of the claims and to pass this application to issue. Additionally, in an effort to expedite and further the prosecution of the subject application, the Applicants kindly invite the Examiner to telephone the Applicants' attorney at (805) 278-8855 if the Examiner has any comments, questions or concerns.

Respectfully submitted,
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VERSION WITH MARKINGS TO SHOW CHANGES MADE**IN THE CLAIMS**

Following are marked-up versions of amended claims 1, 2 and 13:

1. (Four Times Amended) A method for dynamically displaying data values on a client computer, comprising:

[transmitting] receiving transmitted results, sub-items associated with the results, and rules of enforcement of sub-item combinations in a predefined format **[from a server to a remote client]** through a communications interface in response to a request from the client **[to the server]**;

displaying a first set of results on a client display device;

processing the results in real time using the client computer in response to user adjustment of the results and sub-item configuration on the client computer¹, wherein the processing continues even after the communications interface between the server and the client has been terminated²;

preventing sub-item conflicts using the transmitted rules of enforcement; and dynamically displaying the processed results on the client display device.

2. (Thrice Amended) A display device having rendered thereon dynamically changing results of a database query, comprising

a set of results, criteria associated with the set of results, and rules of enforcement of the criteria being stored as information on a server, wherein the information is transmitted from the server **[through a communications interface]** to a remote client that made a request for the results for display on the client, the information being transmitted as encoded data;

at least one dynamic output; and

at least one adjustable interface option displayed on the client adapted to enable adjustment by the remote client of the associated criteria confined within the transmitted rules of enforcement for causing the dynamic output to change in real time

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[even after the communications interface between the server and client has been terminated].

13. (Twice Amended) A method for dynamically displaying pricing data on a client display device comprising:

establishing a communications interface between a client computer and a server computer;

requesting pricing data from the client to the server for at least one object;

generating pricing data with associated options and rules for selection and combination of the associated options for each object at the server;

transmitting the pricing data, associated options, and rules for selection and combination of the associated options from the server to the client;

displaying a first set of pricing results on the client display device;

providing a user interface on the client display device for user interaction with the pricing data and selection and combination of the associated options; and

dynamically updating the pricing data using the client computer to process the update and displaying the pricing data on the client display device in response to user interaction with the pricing data and associated options, and rules for selection and combination[, even after the communications interface between the client computer and the server computer has been terminated].

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